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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUNCAN L. MEWHERTER, AMY D. TRAVIS,
KOAH-HSING WANG, and ROBERT C. WEIR

Appeal 2009-009636
Application 10/685,192
Technology Center 2100

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-22, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates to a system, method and apparatus for converting a slide show presentation for use within a non-presentation application such as a Web conferencing or virtual classroom application. A slide show presentation in its native format is processed to extract slide title information for each slide in the slide show presentation. Additional text within the slide can also be extracted. Each slide in the slide-show is converted to a raster image and disposed within markup. The markup can be annotated with the important text and both the markup and the slide title can be provided to the non-presentation application for use in concert with the non-presentation application. In this way, the context of each slide can be preserved for use within the non-presentation application as can an image of each slide itself. Abstract.

Representative Claim

> 1. A system for converting slide show presentations for use within non-presentation applications, the system comprising:
>
> a slide show produced by a slide show presentation application and stored in a native format; and,
>
> a slide show conversion process configured for coupling to a non-presentation application and programmed both to extract contextual data from said slide show in its native format, and also to convert associated slides in said slide show to raster imagery for use in said non-presentation application.

Examiner's Rejections[1]

Claims 1-5 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 and 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Erol (US 2004/0202349 A1).

Claims 2-4, 6-9, 12, 14-19, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Erol and Chakraborty (US 2004/0194035 A1).

Claims 10, 11, 13, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Erol, Chakraborty, and Chatterjee (US 7,162,691 B1).

Claim Groupings

In view of Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

(1) Is claim 1 directed to computer software *per se*?

(2) Does Erol disclose extracting "contextual data from said slide show in its native format" and converting "associated slides in said slide show to raster imagery" as recited in claim 1?

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[1] The Examiner objected to the Specification for failing to provide proper antecedent basis for the "machine readable storage" recited in claim 16. Rej. 3. Since this is a petitionable— not appealable—matter, we will not address this objection. *See* MPEP § 706.01 ("[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board."); *see also* MPEP § 1201 ("The Board will not ordinarily hear a question that should be decided by the Director on petition….").

FINDINGS OF FACT

We rely on the findings of fact made by the Examiner in the Rejection and the Examiner's Answer.

PRINCIPLES OF LAW

Claim Interpretation

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

Statutory Subject Matter

"The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten,* 500 F.3d 1346, 1354 (Fed. Cir. 2007).

Anticipation

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as

in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

ANALYSIS

Section 101 rejection of claims 1-5

The Examiner finds that claim 1 is directed to a computer program *per se*, which is non-statutory subject matter. Ans. 3-4. Appellants contend that claim 1 recites a process that "extracts data from a slide show in its native format, and also converts associated slides in the slide show to raster imagery – a blatant transformation of an article or physical object to a different state or thing." App. Br. 8; Reply Br. 4-5.

The "system" of claim 1 comprises a "slide show" and a "process … programmed both to extract contextual data … and also to convert associated slides in said slide show to raster imagery." The claim does not recite a process comprising a series of steps. The claim recites, at best, a "slide show … stored in a native format" (e.g., data stored somewhere) and a "process" that, if someday reduced to a tangible form, entered into a computer memory, and executed by a computer, would cause the computer to "extract" and "convert" data.

Even if the claim were to require performing an actual transformation of data within a computer, simply extracting and converting data as claimed would not appear to qualify as a transformation of an article to a different state or thing. Our reviewing court identified a circumstance in which *electronic* transformation of *data* into *a particular visual depiction of a physical object on a display* may be considered a transformation sufficient to render a claimed process patent-eligible. *See In re Bilski*, 545 F.3d 943,

962-63 (Fed. Cir. 2008) (en banc) (discussing *In re Abele*, 684 F.2d 902, 908-09 (CCPA 1982)), *aff'd sub nom. Bilski v. Kappos*, 130 S. Ct. 3218 (2010). The transformation of data within a general purpose computer to generate the "raster imagery" recited by claim 1 is not a type of "transformation" that has been determined sufficient to render a claimed method statutory by the Supreme Court or by our reviewing court.

Appellants do not appear to argue that the "process" is tied to a particular machine or apparatus. Moreover, the claim appears so broad (*see, e.g.*, instant Fig. 1) as to encompass mere software modules for the "process." Software *per se* or a computer program *per se* does not fall within a statutory class. "The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *Nuijten*, 500 F.3d at 1354. *See also* MPEP § 2106.01 ("USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.").

"Abstract software code is an idea without physical embodiment." *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). Because claim 1 is directed to software *per se*, which is not within any § 101 statutory class, we are not persuaded of error in the Examiner's rejection. We thus sustain the Examiner's rejection of claims 1-5 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Section 102 rejection of claims 1 and 5

Appellants contend that claim 1 requires the conversion of contextual data in a slide show into raster imagery. Appellants also contend that Erol does not disclose converting contextual data in a slide show into raster imagery, but rather discloses converting raster imagery into textual data. App. Br. 10-11; Reply Br. 5-6.

Claim 1 does not recite "conversion of contextual data in a slide show into raster imagery." Claim 1 recites "extract contextual data from said slide show in its native format," and "convert associated slides in said slide show to raster imagery." The Examiner finds that paragraphs [0032]-[0034], [0111], and [0118] describe the limitations of claim 1. Ans. 5.

Appellants' Specification states that the system includes a presentation application, such as PowerPoint®, configured to produce a slide show presentation. The contextual elements include text extracted from the slide show presentation. Spec. 8:14-9:1. Paragraph [0111] of Erol describes extracting text from a PowerPoint slide image ("extract contextual data from said slide show") by decoding the syntax of the PowerPoint file ("its native format"). Appellants have not provided evidence or persuasive argument to distinguish "extract contextual data from a slide show in its native format" from extracting text from a PowerPoint slide as described by Erol.

Appellants' Specification (at 3:9) and Appeal Brief (at 10) indicate that a bitmap is an example of "raster imagery." Paragraph [0033] of Erol describes a symbolic information capture device that captures PowerPoint presentation slides by storing the slides as a sequence of images, such as JPEG or BMP (bitmap) images. Appellants have not provided evidence or persuasive argument to distinguish "convert associated slides in said slide

show to raster imagery" from capturing and storing slides of a PowerPoint presentation as BMP images as described by Erol.

We sustain the rejection of claim 1 under 35 U.S.C. § 102. Appellants have not provided arguments for separate patentability of claim 5, which thus falls with claim 1.

Section 103 rejection of claims 2-4 and 6-22

Appellants have not provided arguments for separate patentability of claims 2-4 and 6-22, which thus fall with claim 1.

CONCLUSIONS OF LAW

(1) Claim 1 is directed to computer software *per se*.

(2) Erol discloses extracting "contextual data from said slide show in its native format" and converting "associated slides in said slide show to raster imagery" as recited in claim 1.

DECISION

The rejection of claims 1-5 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 1 and 5 under 35 U.S.C. § 102(e) as being anticipated by Erol is affirmed.

The rejection of claims 2-4, 6-9, 12, 14-19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Erol and Chakraborty is affirmed.

The rejection of claims 10, 11, 13, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Erol, Chakraborty, and Chatterjee is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc